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09/920,323	08/02/2001	Joshua J.D. Martin	088305-0135	4997

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EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/920,323	MARTIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Andrew J. Fischer	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16,21 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16,21 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgements***

1. Applicants' amendment filed December 23, 2005 is acknowledged. Accordingly, claims 1-6, 11-16, 21, and 24-26 remain pending.
2. This Office Action, the "Second Final Office Action" is given Paper No. 20060305.
3. All references in this Office Action to the capitalized versions of "Applicants" refers specifically the Applicants of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
4. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

### ***Claim Rejections - 35 USC §102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-6 and 24 are rejected under 35 U.S.C. §102(e) as being anticipated by Stefanovic et. al. (U.S. 2005/0246266 A1)(“Stefanovic”). Stefanovic discloses the claimed invention including automatically refreshing an auction parameter (“lot number or identification information”) and that the auction parameter is not bid information. In particular [0064] expressly states: “I will be understood that the lot number or lot identification information might be automatically refreshed to the screen of the site terminal (3) as the auction progresses.” It is the Examiner’s principle position that “lot number” is inherently a sponsor determined auction parameter because it is the auction host who determines the lot number within the auction implementing computer system.

### *Claim Rejections - 35 USC §103*

7. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 and 24 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Stefanovic.<sup>1</sup> It is the Examiner’s principle position that the claims are anticipated because “lot number” is inherently a sponsor determined auction parameter because it is the auction host who determines the lot number within the auction implementing computer

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<sup>1</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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system. However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Stefanovic to include designating that lot number or identification information as sponsor determined. Such a modification, by allowing only the sponsor to determine lot number, would have allowed the sponsor to prevent duplicate lot numbers and allowed the sponsor to use lot number as a keyed field in the database.

9. Claims 11-16, 21, 25, and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Stefanovic. Because claims 11-16, 21, 25, and 26 are not patentably distinct from inventions 1-6 and 24, the patentability of claims 11-16, 21, 25, and 26 stands or falls with the patentability of claims 1-6 and 24.

10. Claims 1-6, 11-16, 21, and 24-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Goodwin et. al. (U.S. 2003/0220867 A1) (“Goodwin”). Goodwin discloses the claimed invention including automatically refreshing an auction parameter (“expiration of a predetermined time period”) and that the auction parameter is not bid information. See at least [0006].

### *Claim Interpretations*

11. For due process purposes and because Applicants have not objectively indicated and redefined claim limitation(s) to have meanings other than their ordinary and accustomed meanings, the Examiner confirms that Applicants have decided not to be their own lexicographer. To support this position, the Examiner again notes the following factual findings

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as first discussed in the previous Office Actions.<sup>2</sup> First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements<sup>3</sup> with the required clarity, deliberateness, and precision.<sup>4</sup> Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,<sup>5</sup> Applicants' responses have not point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicants did not argue lexicography *was* invoked). Forth and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation<sup>6</sup> to be their own lexicographer. Finally, after receiving express

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<sup>2</sup> See the First Non Final Office Action mailed May 7, 2004, Paper No. 8, Paragraph No. 15 beginning on page 5; the First Final Office Action mailed February 18, 2005, Paper No. 02112005, Paragraph No. 13 beginning on page 5; and the Second Non Final Office Action mailed August 24, 2005, Paper No. 20050821, Paragraph No. 14 beginning on page 5.

<sup>3</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>4</sup> "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

<sup>5</sup> See Note 2.

<sup>6</sup> See *e.g. Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation:

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notice of the preceding factual findings and conclusions, Applicants' latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicants' latest response—while fully considered by the Examiner—does not change the Examiner's reasonable conclusion that Applicants have decided not to be their own lexicographer. Therefore (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.<sup>7</sup>

12. Under the broadest reasonable interpretation standard noted above and unless expressly modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in the previous office actions. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and

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"applicant's attention was called to the examiner's interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept."

<sup>7</sup> See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]"

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ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary<sup>8</sup>) during ex parte examination.

13. Additionally, the Examiner notes that “the PTO and the CCPA acknowledged product-by-process claims as an exception to the general rule requiring claims to define products in terms of structural characteristics.” *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 845, 23 USPQ2d 1481, 1490 (Fed. Cir. 1992) (hereinafter “*Atlantic Thermoplastics v. Faytex I*”). Furthermore, the Federal Circuit “acknowledges that it has in effect recognized . . . product-by-process claims as exceptional.” *Atlantic Thermoplastics v. Faytex I*, 970 F.2d at 847, 23 USPQ2d at 1491.

Because of this exceptional status, the Examiner has carefully reviewed the claims and it is the Examiner’s position that claims 1-6, 11-16, 21, and 24-26 *do not* contain any product-by-process limitations whether in a conventional format or otherwise. If Applicants disagree with the Examiner, the Examiner respectfully requests Applicants in their next response to expressly point out any product-by-process claim(s) and their limitations so that they may be afforded their exceptional status and treated accordingly. Applicants are reminded that “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.” *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).<sup>9</sup> Failure by Applicants in their next response to also address this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be

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<sup>8</sup> See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) (“[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.”).

<sup>9</sup> See also MPEP §2113.



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considered intent by Applicant(s) *not* to recite any product-by-process limitations. Unless expressly noted otherwise by the Examiner, the preceding discussion on product-by-process principles applies to all examined claims currently pending.

### ***Response to Arguments***

14. Applicants' arguments filed December 23, 2005 have been fully considered but they are not persuasive.

15. As a starting point, Applicants are reminded that unless expressly withdrawn, reversed, or noted elsewhere in this paragraph, all findings of fact and conclusions of law—as indicated in all previous office action(s) within the prosecution history<sup>10</sup> of this patent application—are maintained in this Office Action and will continue to be maintained by the Examiner and the USPTO in any future office actions and/or correspondence.<sup>11</sup> During the course of examination, it is axiomatic that the some of the previously indicated findings of fact and/or conclusions of law may become moot because patent applicants frequently redraft, cancel, or add claims and the

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<sup>10</sup> The prosecution history of this application includes all papers of record and, if applicable, all papers of record in a related application. "The prosecution history contains the complete record of all the proceedings before the Patent and Trademark Office . . ." *Dow Chemical Co. v. Sumitomo Chemical America, Inc.*, 257 F.3d 1372, 1373, 59 USPQ2d 1609, 1614 (Fed. Cir. 2001) (citations omitted). "When a patent is granted, prosecution is concluded, the intrinsic record is fixed, and the public is placed on notice of its allowed claims." *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002). See also *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350, 69 USPQ2d 1815, 1823 (Fed. Cir. 2004) (holding that statements made in prosecution of one patent are relevant to the scope of all sibling patents).

<sup>11</sup> 'Correspondence' includes but is not limited to documents from the USPTO such as office actions, advisory actions, restriction requirements, requests for information, examiner's answers, notice of non-responsive amendments, ex parte Quayle letters, petition decisions, Board of Patent Appeals and Interferences decisions, commissioner's orders, and other documents.

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examiner—in response to those claim changes—subsequently changes the reference(s) used in a statement of rejection. However, to the extent that they remain applicable to the examination process, the Examiner continues to rely on these previously indicated findings of fact and conclusions of law. Second, because patent applicants quite often either do not read an office action or simply fail to comprehend and appreciate the implications of an examiner's findings of fact and/or conclusions of law, any subsequent reiterations, clarifications, and/or discussions of a previously indicated finding of fact and/or conclusion of law in an office action are provided strictly for due process purposes. Thus, unless an examiner provides an express statement either withdrawing or contradicting the previously indicated finding of fact or conclusion of law, these subsequent reiterations, clarifications, and/or discussions are just that—reiterations, clarifications, and/or discussions and are in no way a waiver (either express or implied) by the examiner of his or her position on the matter. Likewise, an examiner's subsequent *omission or failure* to reiterate, clarify, and/or discuss a previously indicated finding of fact or conclusion of law in a subsequent office action is also in no way a waiver (either express or implied) of the examiner's position on the matter. This subsequent omission or failure to reiterate, clarify, and/or discuss a previously indicated finding of fact or conclusion of law in a subsequent office action is intended to shorten the subsequent office action as much as practically possible yet still allow the examiner to rely on those previously indicated findings of fact or conclusions of law. Third, Applicants are reminded that in order to receive a 'Notice of Allowability' (*i.e.* Form PTO-37), an applicant must overcome all outstanding 'objections' and 'rejections'<sup>12</sup> made by an

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<sup>12</sup> Applicants can recognize an 'objection' by the an examiner's express use of the phrase "objected to" in an office action. Likewise, applicants can recognize a 'rejection' by the an

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examiner. Therefore in light of the above and notwithstanding the other sentences in this paragraph, all objection(s) and/or rejection(s) from any previous office action that are not maintained in this Office Action are either overcome by Applicants and/or are hereby withdrawn by the Examiner.

16. Regarding the prior art rejections, Applicants arguments have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

17. Applicants' amendment necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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examiner's express use of the term "rejected" in an office action. Therefore any finding of fact or conclusion of law made by an examiner that does *not* expressly use either the phrase "objected to" or the term "rejected" are *not* considered objections or rejections and are therefore not a "*requirement*" for obtaining a patent as described in MPEP §707.07(e). See also MPEP §706.01 for a discussion of the differences between "objections" and "rejections."

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18. References considered pertinent to Applicants' disclosure are listed on form PTO-892.

All references listed on form PTO-892 are cited in their entirety.

19. Unless expressly noted otherwise by the Examiner or other USPTO official, the following four (4) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action *and* any future office action(s), communication(s), or other correspondence provided by the USPTO: MPEP citations to Chapter 2300 are from the MPEP 8<sup>th</sup> Edition, Rev. 4, October 2005; citations to Chapters 200-900, 1200-1400, and 1700-1900, 2100, 2200, 2600 are from the MPEP 8<sup>th</sup> Edition, Rev. 3, August 2005. MPEP citations to Chapters 100, 1000, 1100, 1500, 2000, 2500, and 2700 are from the MPEP 8<sup>th</sup> Edition, Rev. 2, May 2004. MPEP citations to Chapters 1600, 2300, 2400 are from MPEP 8<sup>th</sup> Edition, August 2001.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21. Applicants are again reminded that patents are written by and for skilled artisans. See *e.g. Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) ("patents are written by and for skilled artisans").<sup>13</sup> The Examiner therefore starts with the presumption that Applicants are skilled artisans who possess

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<sup>13</sup> See also *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1371, 59 USPQ2d 1745, 1749-50 (Fed. Cir. 2001) ("patents are written for persons experienced in the field of the invention").

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at least ordinary skill in the art. Consequently, it is the Examiner's position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicants are hereby given actual notice that if after reasonably reading any reference of record—whether the reference is currently of record or subsequently made of record—if Applicants can not reasonably understand or if Applicants have difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in the reference(s), Applicants should (in their next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicants' response must also state *why* they either do not understand or *why* they have difficulty comprehending the offending reference(s). If after properly receiving (*i.e.* Applicants' response is made of record) both Applicants' request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) in the offending reference. For all documents or references made of record after this Office Action, Applicants are given actual notice that this paragraph becomes effective when Applicants receive notice that the document or reference is made of record (*i.e.* this paragraph becomes applicable when Applicants submit an

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Information Disclosure Statement or when Applicants receive an examiner's Notice of References Cited (Form PTO-892)).

22. Additionally, Applicants are reminded that it is inappropriate for the USPTO to disregard any relevant evidence of record. "It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983). Second, when making substantive patentability determinations, the USPTO uses the preponderance of the evidence standard.<sup>14</sup> In light of this standard, it is clear error for the USPTO not to consider *all* evidence of record. See *e.g. In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) ("All the evidence on the question of obviousness must be considered."); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ("After evidence or argument is submitted by the applicant in response, patentability is determined on *the totality of the record*, by a preponderance of evidence with due consideration to persuasiveness of argument. [Emphasis added.]"); *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002) ("Patentability vel non is then determined on the *entirety* of the record, by a preponderance of evidence and weight of argument. . . . ; patentability is determined by a preponderance of *all* the evidence. [Emphasis added.]"); and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 146 (CCPA 1976) (where the court expressly set forth the issue as "Whether, in light of *all the evidence*, the claimed method would have been obvious at the time the invention was made. [Emphasis added.]"). Third, any factual determination by the USPTO that does *not* consider all relevant evidence of record may not be

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<sup>14</sup> See MPEP §706 I. "The standard to be applied in *all* cases is the 'preponderance of the evidence' test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable. [Emphasis added.]"

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supported by the required substantial evidence<sup>15</sup> since the particular evidence *not* considered may be probative of a factual issue presented. Forth, prior art patents are not technical treatises and therefore these patents intentionally omit features that are known in the field of the invention. “The law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention. ... To hold otherwise would require every patent document to include a technical treatise for the unskilled reader.” *S3 Inc. v. nVIDIA Corp.*, 259 F.3d at 1371, 59 USPQ2d at 1749-50. Finally and perhaps most importantly, it is well established that “[a] reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention.* [Emphasis in original.]’” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous or parallel monitoring is within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at 1701.<sup>16</sup> Therefore because, inter alia, it is inappropriate for the USPTO to disregard

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<sup>15</sup> See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000) where the Federal Circuit concluded that USPTO’s factual findings must be supported by substantial evidence.

<sup>16</sup> See also *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) for the same statement of law and also citing *In re LeGrice*; and *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (B.P.A.I. 1992).

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any relevant evidence, because the USPTO must consider all evidence of record, because any evidence or record *not* considered by the USPTO may be probative of at least one factual issue presented, because prior art patents need not include subject matter that is known in the field of the invention, and because anticipation is determined by the teachings of a reference in combination with the knowledge of one of ordinary skill in the art, Applicants are hereby given actual notice that all prior art rejections (*i.e.* rejection(s) based upon 35 U.S.C. §§ 102 or 103)—if found in this Office Action or any subsequent office action—are based upon the cited reference(s) in the statement of the rejection in combination with the knowledge of one of ordinary skill in this art.

23. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an



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Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

24. Also in accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that Nathan J. Muller's Desktop Encyclopedia of the Internet, ("Desktop Encyclopedia") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Muller's Desktop Encyclopedia is a practical reference that clearly explains Internet services, applications, protocols, access methods, development tools, administration and management, standards, and regulations. Because of the reference's basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the Desktop Encyclopedia is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the Desktop Encyclopedia.

25. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their "Remarks" (beginning on page 6) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal

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conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>17</sup> the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.



Andrew J. Fischer  
Primary Examiner  
Art Unit 3627

AJF  
March 5, 2006

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<sup>17</sup> *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.